



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,431	02/12/2002	Georg Berceli	100564-00094	3687
6449	7590	12/23/2003	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			RODRIGUEZ, JOSEPH C	
		ART UNIT	PAPER NUMBER	
		3653		

DATE MAILED: 12/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SW

Office Action Summary	Application No.	Applicant(s)	
	10/049,431	BERCELI, GEORG	
	Examiner	Art Unit	
	Joseph C Rodriguez	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 03 October 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-3 and 6-23 is/are pending in the application.

4a) Of the above claim(s) 10-23 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3 and 6-9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10/03/2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s) _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

Final Rejection

Applicant's arguments filed 10/3/03 have been fully considered but they are not persuasive for reasons detailed below.

The 35 U.S.C. 112 rejections are maintained or modified as follows:

Claims 1-3 and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding these claims, Applicant has failed to properly respond to the previous Office Action. In particular, it is still unclear what features, or steps, are parts of the claimed invention, as significant portions of the claim language remain nonsensical. For instance, in claim 1, Applicant appears to claim allocating objects "depending on a sorting criterion...at a point that depends on the relevant sorting step" (ln. 4-6), but, as cited below, Applicant has failed to establish specific sorting steps. Consequently, it is unclear how the objects are allocated and sorted or how the features of the sorting device function.

Claim 1 recites the limitation "the relevant sorting step" (ln. 6). There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the next sorting step" (ln. 7). There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the first sorting step" (ln. 11). There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the successive further sorting step" (In. 12). There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the second sorting step" (In. 13). There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the relevant storage area sequence" (In. 17). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the relevant sorting step" (In. 22). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the relevant objects in the sorting steps" (In. 22). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the next sorting step" (In. 24, 25). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the first sorting step" (In. 26). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the successive further sorting steps" (In. 27). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the second sorting step" (In. 28). There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the relevant source storage area sequence" (In. 30, 31). There is insufficient antecedent basis for this limitation in the claim.

Further, regarding claim 6, it is unclear if the language “-maintaining the relevant source storage area sequence for all further sorting steps-“ is a parenthetical comment or an actual required feature of the claimed device

Further, regarding claim 1, the indented paragraph “beginning at the second sorting step, either...” is nonsensical as it is unclear what sorting step, if any, is accomplished as Applicant’s use of “either”-“or” language and multiple modifying phrases makes the scope of the claims unclear.

Examiner recommends amending the claim language to clearly establish the sorting steps and features of the claimed sorting method and device. Examiner further recommends replacing indefinite claim language such as “being relevant”, “either”-“or”, and “respective” to clearly specify what objects are being referred to, how the sorting criterion is established, and how these objects are handled by the sorting method and device.

The prior art rejections are maintained or modified as follows:

Claims 1 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (“Smith”)(US ‘814).

Smith teaches a method and device for sorting a group of objects (Fig. 1-8) wherein a binary representation of the sorting criterion (col. 15, ln. 20 et seq.) is used to sort objects in multiple passes based on a significant digit (Abstract). Here, the plurality of sorting rails (Fig. 1, 8, near 32, 258, 268) can be regarded as the respective conveying paths and storage sections (i.e., conveying circuits) and the switches (near

30, 40, 266, 277) as the diverters. Further, the claimed device features not cited above are clearly depicted in figures 1 and 8.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hart (US '122).

Smith as set forth above teaches all that is claimed except for expressly teaching the forming of sub-groups and the later rejoining of said sub-groups. Hart, however, teaches an object sorting method that utilizes the formation of sub-groups (Abstract). Moreover, this feature simplifies the complex conveyor system and allows for a wider variety of selection criteria (col. 1, ln. 55 et seq.). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Smith as taught above.

Applicant's contentions that the claimed features are not taught above are not persuasive. In particular, Smith teaches multiple sorting rails (Fig. 8, near 258) and storage areas within a recycle loop (Fig. 8, near 252), wherein the rails can be regarded as new storage areas when the objects have been recycled. Further, the claimed benefits of an invention do not distinguish the claimed invention from the prior art. Further, regarding claims 2-3, the motivation to combine is clearly stated above. Consequently, the claims stand rejected.

Specification

The disclosure is objected to as lacking appropriate section headings as outlined in 37 CFR 1.77. See also 37 CFR 1.72-1.77; MPEP § 608.01(a). Correction is required.

Election/Restrictions

Newly submitted claims 10-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons. Here, Applicant has submitted 3 new methods claims and 2 new apparatus claim groupings. These newly submitted method and apparatus groupings are distinct from the original method and apparatus grouping as each process can be practiced by a materially different apparatus and each apparatus grouping can be practiced by a materially different process. See MPEP 806.05 (e).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

A complete reply to this final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Examiner has maintained the prior art rejections, statutory rejections and drawing objections as previously stated and as modified above. Applicant's amendment

necessitated any new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C Rodriguez whose telephone number is **703-308-8342**. The examiner can normally be reached on M-F during normal business hours (9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **703-872-9326** (After-Final **703-972-9327**).

The **UnOfficial** fax phone number for the organization where this application or proceeding is assigned is **703-306-2571 or 703-308-6552**.

The examiner's **UNOFFICIAL Personal fax number** is **703-746-3678**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

December 16, 2003



DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600